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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,069	02/19/2004	Heribert Bucher	16589-4	1155
7590 Clifford W. Browning Woodard, Emhardt et al. LLP Bank One Center/Tower, Suite 3700 111 Monument Circle Indianapolis, IN 46204-5137			EXAMINER STOCK JR, GORDON J	
			ART UNIT 2877	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/784,069

Applicant(s)

BUCHER ET AL.

Examiner

Gordon J. Stock

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Amendment received on September 25, 2006 has been entered into the record.

#### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Drawings*

3. The Drawings filed on February 19, 2004 are accepted by the Examiner.

#### *Claim Objections*

4. **Claims 11 and 16** are objected to for the following: 'the measuring beam' of line 5 of **claim 11** and line 6 of **claim 16** lacks antecedent basis. Corrections required.
5. **Claim 20** is objected to for the following: **claim 20** depends from **claim 11** which is a method. Therefore, 'device according to claim 11' should read 'method according to claim 11--'. Correction is required.

#### *Claim Rejections - 35 USC § 101 and 35 USC § 112*

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 11-17 and 20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 11-17 and 20** are directed to a judicial exception; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely ‘determining the position of the tool from the measuring position (line 8 of **claim 11**; line 9 of **claim 16**)’ would not appear to be sufficient to constitute a tangible result, since the outcome of the determination has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of the claims is not patent eligible. **Claims 12-15, 17, and 20** are rejected for depending upon a rejected base claim; wherein **claims 12-15, 17, and 20** further limiting of the parent claim still does not have a tangible result.

8. **Claim 20** is rejected under 35 U.S.C. 112 second paragraph as being indefinite, for **claim 20** claims both an apparatus, a device comprising an optical measuring device with a transmitter and receiver and the method for **claim 20** depends from the base method **claim 11**. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990)*.

**Claims 20** is also rejected under 35 U.S.C. 101 based on the theory that **claim 20** is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

*Allowable Subject Matter*

9. **Claims 11-17** would be allowable if rewritten to overcome the rejection under 35 U.S.C. 101 above and to overcome the objections above.

As to **claims 11 and 16**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of determining position of a rotationally drivable tool wherein the tool position is positioned in the beam path of the measuring beam before it is moved away from the measuring beam and the measuring position is detected for a position of the tool in which the measuring beam is not interrupted during at least one revolution of the tool, in combination with the rest of the limitations of **claims 11-17**.

*Response to Arguments*

10. Applicant's arguments, see Remarks, filed September 25, 2006 with respect to the previous rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) with Bucher et al. (WO 01/28737) have been fully considered and are persuasive. The previous rejections under 35 U.S.C. 102(b) and U.S.C. 103(a) (see Action: 20060622) have been withdrawn. The Examiner apologizes for the inconvenience but upon further consideration a rejection under 35 U.S.C. 101 has been made (see above).

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent 3,749,500 to Carlson et al.

U.S. Patent 4,021,119 to Stauffer

U.S. Patent 4,576,482 to Pryor

U.S. Patent 5,004,930 to Gremaud et al.

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U.S. Patent 5,005,978 to Skunes et al.

U.S. Patent 5,930,143 to Savazzi

US 2006/0232791 to Turrini

***Fax/Telephone Numbers***

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

- 1) Contain either a statement "DRAFT" or "PROPOSED AMENDMENT" on the fax cover sheet; and
- 2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

*Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: (571) 273-8300*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (571) 272-2431.

The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached at 571-272-2800 ext 77.

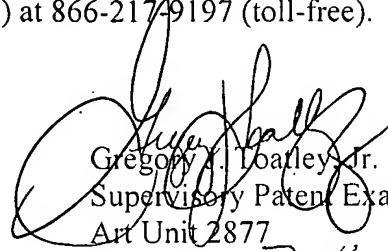
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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gs

December 7, 2006

  
Gregory A. Loatley, Jr.  
Supervisory Patent Examiner  
Art Unit 2877  
4 Dec 06